



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/709,477	11/13/2000	Isabelle Preuilh	2365-23	4547

23117 7590 04/08/2005
NIXON & VANDERHYE, PC
1100 N GLEBE ROAD
8TH FLOOR
ARLINGTON, VA 22201-4714

EXAMINER

MITCHELL, GREGORY W

ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 04/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/709,477

Applicant(s)

PREUILH ET AL.

Examiner

Gregory W Mitchell

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-33,35-46 and 50-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-33,35-46 and 50-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claims 32-33, 35-48, 50-61 are pending. The Amendment filed October 08, 2003 amended claims 31, 40 and 50 and canceled claim 49.

Applicant's arguments and amendments filed October 08, 2003 are sufficient to overcome the 35 USC 112 rejections of the Office Action dated April 08, 2003.

In accordance with the Petition Decision dated December 22, 2004, this Office Action vacates the Office Action dated November 25, 2003.

Priority

Receipt is acknowledged of papers submitted under 35 USC 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

Art Unit: 1617

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 31, 32, 37-48, 50-51, 55, 57-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cameron (USPN 4722837) in view of Andrews et al. (USPN 5378731) and in view of The Handbook of Cosmetic Science and Technology.

The instant claimed invention is directed toward a composition comprising, in an aqueous medium, an active principle selected from a corticoid or a retinoid, an anionic surfactant, an amphoteric surfactant, and 0.1-25% of a propenetrating agent.

Cameron teaches a medicated shampoo composition comprising 0.1-0.5% hydrocortisone, 20-35% detergent, 1-6% thickener, preservative and other ingredients, wherein the detergent can be a combination of sodium lauryl sulfate and coamidopropyl betaine. The reference fails to teach propenetrating agents, the combination of an anionic and amphoteric surfactant, and fails to explicitly state the pH. See col. 1, line 5-col. 6, line 35.

Andrews et al. teaches medicated shampoos. Propylene glycol in an amount of 0.1-5% is taught as a viscosity modifier that serves to alter the viscosity of the composition so as to achieve a desired viscosity. It is taught that a thicker, more viscous shampoo may be desired for those having short hair, while those with longer hair usually prefer a less viscous shampoo. See col. 6, lines 15-39. For shampoos exemplified as having a pH from 3.6-3.8, see col. 11, lines 9-44.

The Handbook of Cosmetic Science and Technology teaches that amphoteric surfactants provide foam stabilization in combination with the ability to mitigate irritancy of other materials, such as primary surfactants and, in some cases, will modify product

Art Unit: 1617

viscosity. They are taught as compatible with anionic surfactants, wherein anionic surfactants are taught as the primary surfactants. See pages 220-4.

It would have been obvious to one of ordinary skill in the art at the time of the invention to add 0.1-5% propylene glycol, as taught by Andrews et al., to the composition of Cameron because of an expectation of achieving a composition in which the viscosity can be altered so as to achieve a shampoo that is preferable to those with long hair and those with short hair.

Additionally, it would have been obvious to one of ordinary skill in the art at the time of the invention to teach the pH of the shampoos of Cameron as 3.6-3.8, as taught by Andrews et al., because of the expectation of achieving a cosmetically acceptable formulation that is safe for application to the hair and scalp.

It would have been obvious to one of ordinary skill in the art at the time of the invention to teach the composition of Cameron comprising both the anionic and amphoteric surfactants because of the expectation of achieving a composition that is more stable and decreases irritation, as taught by the Handbook of Cosmetic Science and Technology.

While the ratio of anionic to amphoteric surfactant is not taught, it is respectfully pointed out that it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Examiner respectfully points out that the recitation "foaming" and "for washing and treating the hair and/or scalp" has not been given patentable weight because the

Art Unit: 1617

recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Claims 33, 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cameron, Andrews et al. and The Handbook of Cosmetic Science and Technology as applied to claims 31, 32, 37-48, 50-51, 55, 57-61 above, and further in view of Kligman (USPN 5998395).

Cameron, Andrews et al. and The Handbook of Cosmetic Science and Technology apply as disclosed above. The references do not specifically teach the preferred corticoids and retinoids.

Kilgman teaches methods of treating inflammatory dermatosis. Disclosed are compositions comprising a combination of clobetasol propionate or trimcinolone acetonide or hydrocortisone and tretinoin, wherein the corticosteroid comprises 0.00001-3% of the composition. It is disclosed that these compounds work synergistically. The compositions are disclosed as taking on various forms, such as creams, dressings, gels, lotions, ointments or liquids. Further examples of suitable retinoids disclosed include retinyl palmitate and retinyl propionate. The retinoids can be natural or synthetic. See col. 1, line 19-col. 12, line 20.

Art Unit: 1617

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the corticoids and retinoids taught by Kligman into the composition of the combined references because of the expectation of success in achieving a composition that exhibits a synergistic effect in treating chronic dermatoses, such as seborrheic dermatitis, atopic dermatitis, contact dermatitis, psoriasis, and others, and because it is obvious to combine individual compositions taught to have the same utility to form a new composition for the very same purpose. *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

Claims 52-54 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cameron, Andrews et al. and The Handbook of Cosmetic Science and Technology as applied to claims 31, 32, 37-48, 50-51, 55, 57-61 above, and further in view of Cauwet et al. (USPN 5661118).

Cameron, Andrews et al. and The Handbook of Cosmetic Science and Technology apply as disclosed above. The references do not specifically teach cationic polymers and ceramides.

Cauwet et al. Teaches hair and skin washing and treatment compositions based on ceramide and/or glycosphingolipid and cationic polymers. The combination of cationic polymer and ceramide and/or glycosphingolipid provides synergistic detangling. Cationic polysaccharides are taught as cationic polymers. Disclosed is a composition comprising sodium lauryl ether sulphate, cocoylbetaine, ceramide A, and guard hydroxypropyltrimmonium chloride. Nonionic surfactants are disclosed as constituents

Art Unit: 1617

that may be especially contained within the composition. Cationic polymers comprise 0.05-5% of the composition. See col. 13, line 1-col. 20, line 65.

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the cationic polymer and ceramide taught by Cauwet et al. to the composition of the combined references because the expectation of success in providing a shampoo with synergistic detangling effects.

Response to Arguments

Regarding Cameron, Applicant argues, "The examples only contain an anionic surfactant." This argument is not persuasive. Examiner respectfully points out that this is a 103 obviousness type rejection and not a 102 anticipatory type rejection, wherein it is well established that consideration of a reference is not limited to the preferred embodiments or working examples, but extends to the entire disclosure for what it fairly teaches, when viewed in light of the admitted knowledge in the art, to a person of ordinary skill in the art. *In re Boe*, 355 F.2d 961, 148 USPQ 507 (CCPA 1966); *In re Lamberti*, 545 F.2d 747, 19USPQ 279 (CCPA 1976); *In re Fracalossi*, 681 F.2d 792, 215 USPQ 569 (CCPA 1982); *In re Kaslow*, 707 F.2d 1366, 217 USPQ 1089 (Fed. Cir. 1983).

It is noted that Applicant's arguments with regard to Preuilh et al. are moot in view of the instant rejections.

Applicant argues, "None of the two remaining documents, namely Preuilh et al. and The Handbook of Cosmetic and Sciences and Technology, indicated or suggest

Art Unit: 1617

that the colloidal sulphur can be removed from the composition of Cameron et al. and that a stable composition could be obtained also with the combination as claimed, for example in claim 31." This argument is not persuasive. Examiner respectfully points out that Applicant's open-ended language in the instant claims, the term "comprising", does not exclude any ingredients from its composition. Thus, the rejection need not remove colloidal sulphur from the composition of Cameron to read on the instant claims.

Applicant argues, "The problem raised in Kligman relates to control and to clear more effectively the inflammatory dermatosis. This problem has been solved by Kligman by using the particular combination corticosteroid/retinoid." This argument is not persuasive. Examiner respectfully points out that Kligman is merely relied upon to teach specific retinoids that can be added to the composition of Cameron for the purpose of treating inflammatory dermatosis of the scalp. One of skill in the art would be motivated to add the specific corticosteroids and retinoids as taught by Kligman to the composition of Cameron because of the expectation of effectively treating flaking, scaling, dandruff, psoriasis, eczema, seborrhea, and other inflammatory dermatosis of the scalp.

Applicant argues, "The problem raised in the present application does not consist in using new active principle as taught by Kligman et al., but consists in improving the penetration of the active principle while improving the characteristics of volume and compactness of the foam and allowing the hair to exhibit good cosmetic properties such as softness, non-greasiness and manageability." This argument is not persuasive

Art Unit: 1617

because it is not commensurate in scope with the instant claims. It is noted that the instant claims are directed to a composition, not a problem to be solved.

Applicant argues, "Cauwet does not teach the combination of anionic and amphoteric surfactants with active principles and propenetrating agents, as present claimed." This argument is not persuasive as Cauwet is merely relied upon to teach cationic polymers and ceramides.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory W Mitchell whose telephone number is 571-272-2907. The examiner can normally be reached on M-F, 8:30 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gwm



SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER